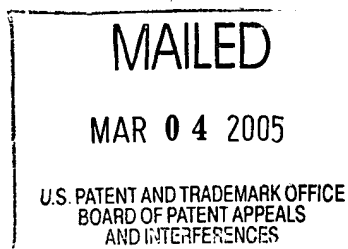


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOKUNORI KATO and SUSUMU CHIDA

Appeal No. 2004-1706
Application No. 09/266,922

HEARD: February 8, 2005

Before DIXON, BLANKENSHIP, and SAADAT, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-24,
which are all of the claims pending in this application.

We AFFIRM-IN-PART.

Appellants' invention relates to a communication terminal apparatus and method. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A communication terminal apparatus comprising:

a first memory that stores parameters for each of a plurality of geographical divisions and at least one operation-control program;

a second memory; and

a control device that initializes the second memory on the basis of parameters for a selected geographical division, the parameters for the selected geographical division being read from the first memory.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Hiyokawa et al. (Hiyokawa)

6,333,702

Dec. 25, 2001
(filed Dec. 2, 1996)

Claims 1-24 stand rejected under 35 U.S.C. § 103 as being anticipated by Hiyokawa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's final rejection (Paper No. 7, mailed Oct. 22, 2002), and the examiner's answer (Paper No. 15, mailed Sep. 10, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 14, filed Jun. 24, 2003) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellants have elected seventeen groupings of claims. We will select a representative claim from each grouping as needed and address appellants' arguments. Furthermore, appellants argue that Hiyokawa fails to anticipate the subject matter and that the rejection under 35 U.S.C. § 103(a) should be reversed. Clearly, appellants intended to argue that the rejection under 35 U.S.C. § 102 should be reversed.

Initially, we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (**see Hazani v. United States Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however,

the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (**see Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1.

CLAIM 1

Here, we find that the language of independent claim 1 recites a generic "communication terminal" in the preamble and the first limitation of the claim recites "a first memory that stores parameters for each of a plurality of geographical divisions and at least one operation-control program." From our reading of the teachings of Hiyokawa and the discussion of the application of the teachings of Hiyokawa to the claimed invention (final rejection at pages 3-4), we agree with the examiner that Hiyokawa teaches the use of a first memory that stores geographical divisions and at least one program and that initialization of a second memory based on the stored geographical division. The examiner maintains that the term "initialize" in the claim is interpreted to "simply denote the storing of new data into an area [of memory]." (Answer at page 3.)

We agree with the examiner's interpretation of the term and do not find the interpretation to be an unreasonable interpretation. We reviewed appellants' specification and have not found any express definition of the term and appellants have not identified any specialized definition or provided an extrinsic definition which is clearly contrary to the examiner's interpretation. Therefore, we accept this interpretation as reasonable.

Appellants argue that they may be their own lexicographer at page 10 of the brief. Appellants further argue that when a memory is initialized, the memory is set to a "starting position or value" and that Hiyokawa performs two types of initialization, but Hiyokawa does not disclose the initialization of the flash memory or any other memory based on parameters for a geographical division. (Brief at page 11.) We disagree with appellants and find that the mere storage of the geographical data in the system of Hiyokawa as the examiner maintains would have read on the claimed limitation. Appellants argue that Hiyokawa fails to disclose any other initialization because Hiyokawa fails to reset the flash memory 3, RAM 4 or any other memory to a starting position or value. Appellants argue that the examiner's reliance upon the setting of a new destination and determining a new guide route does not set a new starting position or value. (Brief at page 12.) Appellant further argues that the destination processing step does not perform "initialization processing" since the memory is not set to a new starting position or value. (Brief at page 12.) We disagree with appellants. From our

review of the language of independent claim 1, we find no details recited as to the details of the "initialization processing."

Appellants argue that "Hiyokawa stores a plurality of geographical divisions in the data storage medium. However, Hiyokawa fails to select a particular geographical division. Naturally, Hiyokawa fails to disclose storing navigation processing programs in the flash memory 3 based on a geographical division selected from a plurality of geographical divisions." (Brief at pages 12-13.) We find that this argument is not commensurate with the express limitations as recited in independent claim 1. Therefore, this argument is not persuasive. Furthermore, appellants' arguments appear to try to force the "initialization" into the start up initializations of Hiyokawa which is clearly not what the examiner has explained in the rejection of independent claim 1. Therefore, this argument is not persuasive.

Appellants argue that Hiyokawa understands that their navigation system can be used in a plurality of geographical divisions and Hiyokawa fails to compensate for different parameters that exist in different geographical divisions. Therefore, Hiyokawa teaches away from initializing bases on parameters for a selected geographical division. (Brief at page 13.) Here, is where appellants' argument fails. Appellants seem to be arguing that Hiyokawa does not do what the disclosed invention does with respect to configuring the device for the geographic division prior to its use, rather than replying to the rejection as applied and interpreted by the examiner which is an initialization of the

memory during the use of the device. From our review of the disclosed invention, we would describe the initialization as more of a customization or a configuration of the device based upon geographical parameters. Here, the language of the claim does not set forth such detail. We find that independent claim 1 merely sets forth an apparatus and not a process of configuring an apparatus. Therefore, this argument is not persuasive, and we will sustain the examiner's rejection of independent claim 1.

CLAIMS 2-4 AND 21

The examiner maintains that Hiyokawa teaches the use of at least one geographical division specific parameter and a non-geographical division specific parameter for each of the plurality of geographical divisions. (Final rejection at page 4.) The examiner further maintains that Appellants argue that non-geographical division specific parameter would be the navigation programs since they are not geographic specific. (Answer at page 6.) We disagree with the examiner since we find no teaching in Hiyokawa that the navigation programs are stored with each of a plurality of geographic divisions which are stored in the first memory. Therefore, we agree with appellants that the examiner has not established a ***prima facie*** case of anticipation of dependent claim 2 and dependent claims 3, 4 and 21 which depend therefrom.

CLAIMS 5 AND 6

Appellants argue that the limitations of both claims 5 and 6 are not taught by Hiyokawa at page 16 of the brief, but we note that each of these claims depends from independent claim 1 separately. Therefore, this argument is not persuasive.

Additionally, appellants repeat the argument that independent claim 1 is not taught by Hiyokawa. This argument is not persuasive, as discussed above, and we will sustain the rejection of dependent claim 5 and dependent claim 6 which is grouped therewith.

CLAIMS 7-11 AND 22

Appellants argue that Hiyokawa does not teach a determining device that determines whether the specification stored in the second specification storing device is a predetermined specification. (Brief at page 17.) The examiner maintains that Hiyokawa teaches this limitation at columns 11, 12 , 39, and 40. (Final rejection at page 6.) We disagree with the examiner and find no determination as recited in the language of independent claim 7. Therefore, the examiner has not established a ***prima facie*** case of anticipation, and we cannot sustain the rejection of independent claim 7 and its dependent claims 8-11 and 22.

CLAIM 12

With respect to independent claim 12, appellants argue essentially the same rationale on pages 22-26 of the brief, as discussed above with respect to independent claim 1, which we did not find persuasive. Similarly, we do not find appellants' argument persuasive with respect to independent claim 12, and we will sustain the rejection of independent claim 12.

CLAIMS 13-15 AND 23

We find dependent claim 13 to be similar in scope to dependent claim 2 above which we found that the examiner did not establish a *prima facie* case of anticipation. Similarly, we find that the examiner has not established a *prima facie* case of anticipation and we will not sustain the rejection of dependent claim 13 and dependent claims 14, 15 and 23.

CLAIM 16

Here, appellants repeat the argument made with respect to independent claim 12 which we did not find persuasive. Similarly, we do not find the argument persuasive with respect to dependent claim 16 and find no specific argument with respect to the limitation of claim 16. Therefore, this argument is not persuasive, and we will sustain the rejection of dependent claim 16.

CLAIM 17

Claim 17 corresponds to the method of independent claim 7 above which we found that the examiner did not establish a ***prima facie*** case of anticipation. Again, the examiner relies upon the same basis for the rejection which we did not find as a ***prima facie*** case of anticipation. Therefore, we will not sustain the rejection of independent claim 17 and dependent claims 18-20 and 24.

CLAIMS 21-24

Claims 21-24 recite that at least one of the geographical division specific parameters is a parameter regarding communication standards adopted in a geographical division. Appellants argue that Hiyokawa does not disclose a parameter regarding communication standards adopted in a geographical division. The examiner maintains that columns 39 and 40 of Hiyokawa teach the claimed limitation. (Final rejection at pages 9-10 and answer at pages 11-12.) We disagree with the examiner that these numbers or symbols teach a parameter regarding communication standards adopted in a geographical division as recited in the claims. Therefore, we find that the examiner has not established a ***prima facie*** case of anticipation, and we will not sustain the rejection of dependent claims 21-24.


CONCLUSION


To summarize, the decision of the examiner to reject claims 1, 5, 6, 12, and 16 under 35 U.S.C. § 103 is affirmed, and the decision of the examiner to reject claims 2-4, 7-11, 13-15, and 17-24 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED-IN-PART


JOSEPH L. DIXON
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge


MAHSHID D. SAADAT
 Administrative Patent Judge

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